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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,670	07/13/2001	Chui-Kuei Chiu	4425-162	1841

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EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/903,670

Applicant(s)

CHIU, CHUI-KUEI

Examiner

Madeleine AV Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This communication is responsive to amendment filed on August 17, 2005.

Applicant cancels claims 1-17 and adds new claims 18-27.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 18-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 18-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 18-27 is drawn to a method and apparatus that merely manipulates data or an abstract idea, or merely solves a mathematical problem without a limitation to a practical application in the technological arts. For instance, claims 18-19, 23-24 claim a method or apparatus for saving information, summing them and produce an average value; claims 20-22, 25-27 claim a method or apparatus for performing first and second subtraction, summing the results and produce an average value. There is no practical application in the technological arts.

In order for a claimed invention to accomplish a practical application, it must produce a "useful, concrete and tangible result" *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02 (see MPEP 2106.II.A). A practical application can be achieved through recitation of "a physical

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transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan”, or “limited to a practical application within the technological arts” (MPEP 2106 IVB2(b)). Currently, claims 18-22 meet neither of these criteria. In order to for the claimed process to produce a “useful, concrete and tangible” result, recitation of one or more of the following elements is suggested:

- The manipulation of data that represents a physical object or activity transformed from outside the computer (MPEP 2106 IVB2(b)(i)).
- A recitation of a physical transformations outside the computer, for example in the form of pre or post computer processing activity (MPEP 2106 IVB2(b)(i)).
- A direct recitation of a practical application in the technological arts (MPEP 2106 IVB2(b)(ii)).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 19 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 19 and 24, “the value of the saved information” is definite on whether it is the saved information of the first pixel from the first scan, or the replaced summed pixel information from the first and second scans.

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4. Claim 18 recites the limitation "the first pixel from the second scan" in line 6. There is insufficient antecedent basis for this limitation in the claim.

5. Claim 19 recites the limitations "the saved information" and "the value" in lines 1-2. There is insufficient antecedent basis for these limitations in the claim.

6. Claims 21, 26 recite the limitations "the value" in line 1. There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagoshi et al (US Patent No. 6,164,745).

Concerning claims 18 and 23, Nagoshi discloses an apparatus and method (Figs. 1A-4A, 41) comprising means of or steps for scanning a test pattern a first time (first forward scan), saving information for a first pixel from the first scan; scanning the test pattern a second time (third forward scan), summing the information for the first pixel from the first scan with the first pixel from the second scan; replacing the saved information with the summed pixel information from the first and second scans (sum of recorded pixels by forward scan), (col. 22, lines 1-61; col. 42, line 39 – col. 43, line 36).

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It is noted that the claims state means or steps relating to “the first pixel” of the first and second scans and not “only the first pixel” of the first and second scans. Nagoshi teaches the sum of pixels of the first and second scans. That includes the sum of the first pixel of the first and second scans.

Nagoshi does not specifically teach that the test pattern is a calibration chart. However, it was commonly known that the calibration chart is also a test pattern since it is for testing and calibrating an apparatus. It would have been obvious to one skilled in the art at the time the invention was made to modify the test pattern in Nagoshi to a calibration chart since it is also a test pattern in the test pattern printing mode of a recording or printing medium.

Concerning claims 19 and 24, Nagoshi further teaches the producing of an average value (col. 44, lines 28-65).

Concerning claims 20-23 and 25-27, Nagoshi et al discloses an apparatus and method as discussed in claims 18-19, 23-24 above. Nagoshi fails to teach in details the summing of the first and second subtraction results for an averaging process. However, it was known in the art that an averaging process could be performed by dividing a summing of a first and second subtraction results by the number of times of subtraction operations to get an average value. It would have been obvious to one skilled in the art at the time the invention was made to modify the averaging process in Nagoshi by subtracting a base value from a value for a first pixel from the first scan to get a first result, subtracting a base value from a value for a first pixel from the second scan to get a second result and then summing the results in order to produce an average value since, while the way of performing the average process is different, it can lead to the same

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end result of producing an average value. In addition, Nagoshi also teaches the summation of the difference between the first and second scans (col. 44, lines 28-65).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

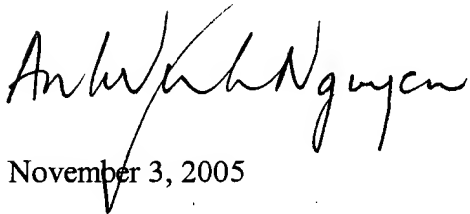
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 571 272-7466. The examiner can normally be reached on Monday, Tuesday, Thursday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on 571 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Madeleine AV Nguyen". The signature is fluid and cursive, with the first name "Madeleine" and last name "Nguyen" being clearly legible.

Madeleine AV Nguyen
Primary Examiner
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November 3, 2005